

## REMARKS

Claims 1-39 are pending in the present application. Claims 1, 6, 7, 10, 16, 17, 19, 20, 21, 32, 34, 38 and 39 have been amended.

### Rejection under 35 U.S.C. § 112

Claim 22 was rejected under 35 U.S.C. § 112, first paragraph, as not enabling. The Applicant believes that the Examiner's rejection relates to claim 23, not claim 22.

Claim 20 has been amended to remove any possible logical inconsistency.

Claim 20 now recites that the system automatically allocates a reward to the user without manual pre-registration of the user by the user. That is, in claim 20, the user does not pre-register or have to take any prior steps to take advantage of the present invention.

A cookie also does not require the user to do anything -- a cookie is automatically stored without user intervention. A cookie does not require any manual pre-registration by the user.

Accordingly, it is respectfully submitted that there is no conflict between claim 20 and claims 22 or 23.

Reconsideration and withdrawal of the rejection of claim 22 under 35 U.S.C. § 112, first paragraph, is respectfully requested.

Rejections under 35 U.S.C. § 102 and § 103

Claims 1, 5-13, 16-22, 24, 25, 32-35 and 38 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,855,007 to Jovicic et al. (“Jovicic”), or in the alternative, under 35 U.S.C. § 103 as being obvious over Jovicic. Claims 2-4, 14-15, 23, 26-31, 36, 37 and 39 were rejected under 35 U.S.C. § 103 as being obvious over Jovicic.

The Jovicic patent was referred to and distinguished in the Background section of the specification of the present invention, as follows, at p. 5:

“Another example is U.S. Patent No. 5,855,007 to Jovicic et. al. This patent describes an electronic coupon communication system for generating and redeeming product discount coupons over the Internet. Again, the coupon must be stored on or printed at the user’s computer.”

There are many fundamental differences between the present invention and the Jovicic patent. These are differences in purpose, architecture and operation.

The problem that the Jovicic patent aims to solve is the management of coupons. Traditionally, a coupon is a paper-based document that entitles the holder to a discount on a product or service. It is time-consuming to manage coupon collection and redemption.

In contrast, the present invention is directed at exciting users to respond to (e.g., click on) electronic advertisements on the Internet. The present invention provides an incentive to drive traffic to a website.

Because of this fundamental difference of purpose, there are many differences between the claims of the present invention and the Jovicic patent, as discussed below. Moreover, for these reasons, the present invention is not obvious in view of

the Jovicic patent.

- ***Jovicic's coupon is collected and stored by user***

In the Jovicic patent, a user selects and obtains coupons. As stated above, a coupon is a bearer-instrument that entitles the holder to a discount on a product or service. A coupon must be collected (or "clipped" by the customer), and then provided by the customer to the merchant for redemption.

Thus, in the Jovicic patent, the coupon is provided to the customer/user. Either the coupon is printed at the user's computer or sent electronically to the user and stored on the memory of the user's computer. The user then redeems the coupon -- that is, the user provides the coupon to the merchant. In summary, in the Jovicic patent, the user selects a coupon from a central location, the coupon is provided to the user, and the user then provides the coupon to the merchant for redemption.

In contrast, according to the present invention, rewards are stored centrally. There is no need for the rewards to be transmitted to or stored by the user. As stated at page 7, lines 17-20, of the Specification of the present invention, this provides a significant advantage:

"... rewards are maintained in a central database. This makes administration and control of the system simpler and more efficient. Additionally, it prevents users from misplacing rewards to which they are entitled."

As would be appreciated, a user of the coupons in the Jovicic patent could misplace or lose a coupon prior to redemption. This would not occur in relation to the present invention.

Moreover, in the Jovicic patent there is a communication cost in transmitting the coupon to the user. In contrast, according to the present invention:

“There is no need for rewards to be electronically or otherwise transmitted or sent to the user.” (Specification, p. 11, lines 1-2).

- ***Jovicic’s coupon is collected from a central location***

In the Jovicic patent, a user obtains a coupon by visiting a central location (called the “Internet coupon server” in the Jovicic patent). That is, the user goes to a central location to view coupons that are available, and then selects coupons of interest.

In sharp contrast, according to the present invention, there is no central location to view and select rewards prior to allocation to the user. According to the present invention, a reward is allocated to the user when the user selects an advertising image. Typically, an advertising image is a banner advertisement on a webpage. The banner advertisements need not be stored on a central “coupon server” for selection, but typically are available for selection at many different websites.

With respect, the Examiner may have confused the “Internet coupon server” of the Jovicic patent (where coupons which have not been allocated to the user are available for selection by a user) with the central database of the present invention (that stores the rewards that the user is entitled to, the user having previously selected an advertising image.)

In short, in Jovicic, the user selects a coupon from many available

coupons from a central “Internet coupon server”, and the coupon is then transmitted to the user. In the present invention, the user selects an advertising image (not required to be in a central location) and a reward is allocated (but not necessarily transmitted) to the user and this fact is stored at a central database.

- ***Jovicic does not have a central database of rewards that the user is entitled to redeem and that is accessible by the user***

In the Jovicic patent, once a user selects a coupon, it is transmitted to the user. If the user misplaces the coupon, that is the user’s loss. The user cannot access any central location to find out which coupons the user had collected. If the user wishes to redeem a coupon, the user must have possession of it. The Jovicic patent has a central coupon database 130 (and see col. 2, lines 49-51), but the purpose of this coupon database is to create customized coupons, and to prevent fraud, not to allow a user to find out what coupons he or she had collected. For fraud prevention purposes, the Jovicic system would not allow the user to directly interact with coupon database 130 of the Jovicic system.

In contrast, in the present invention, rewards that have been allocated to the user are stored centrally. The user can access this central location to see which rewards the user has “collected.” To redeem a reward, the user accesses and interacts with the central location.

For example, in relation to claim 32, the Examiner cites col. 3, lines 11-15 of the Jovicic patent as teaching a central computer comprising a central

database storing a list of rewards that have been previously collected by the user and that are available for redemption. Col. 3., lines 11-15 of Jovicic clearly states the opposite, that the coupons are stored “in the memory of the user’s general computing device”. With respect, the Examiner has misunderstood the architecture of the Jovicic patent.

In relation to claim 7, which is directed to these features, the Examiner does not cite any part of the Jovicic patent that teaches the *allowing access* steps of claim 7. There is no need for the user to have such access in the Jovicic patent, because the user has possession the coupon, which is not necessarily the case in relation to the present invention.

- ***To redeem Jovicic’s coupon, the user must provide it to the merchant***

In the Jovicic patent, if a user wishes to redeem a coupon, the user must provide it to the merchant.

In sharp contrast, in the present invention, the user does not need to have the reward (and the rewards that the user has are centrally stored in the central database). Thus, to redeem a reward, the reward is provided from the central database to the merchant. (See Options 1 and 2 on pages 9 and 10 of the Specification.) Unlike Jovicic, the reward does not need to pass through the user’s hands.

- ***Jovicic does not have a “reward indicator”***

In the Jovicic, the coupon specifically sets out that it is a discount coupon and directly specifies the discount.

According to the present invention, and unlike a coupon, the

advertising image may not specify the nature of the reward (Specification, page 11). Rather, the advertising image includes a “reward indicator” which is, for example, a distinctive logo, border or icon. The “reward indicator” is in addition to and part of the advertising image, and need not specify the reward to which the user will be entitled if the user selects the advertising image.

- ***Jovicic does not teach directing a local computer to a webpage associated with the coupon***

In the Jovicic, the purpose of the system is to enable users to easily collect coupons. It is not a purpose of the Jovicic patent to increase traffic to Internet websites. It is not inherent to do so in the Jovicic patent, and nowhere does Jovicic suggest such a purpose.

At the priority date of the present invention, it was not obvious to user coupons as a mechanism to drive traffic to websites or to increase click through rates of banner advertisements. The purpose of a coupon was considered to be to encourage a person to purchase the product shown on the coupon, not to drive traffic to a website (that, according to the present invention, need not be related to the reward at all.)

Reconsideration and withdrawal of the rejection of claims 1-39 under 35 U.S.C. §§ 102(e) and 103(a) is respectfully requested.

**CONCLUSION**

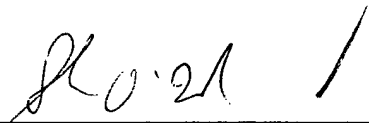
The Applicants respectfully submit that the present case is in condition for allowance and respectfully requests that the Examiner issue a notice of allowance.

The Office is hereby authorized to charge any fees determined to be necessary under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayment to Kenyon & Kenyon **Deposit Account No. 11-0600.**

The Examiner is invited to contact the undersigned at (202) 220-4255 to discuss any matter concerning this application.

Respectfully submitted,

Dated: May 24, 2004

  
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